



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/592,945 | 03/14/2007 | Anne Berthereau | 295797US0PCT | 8698 |
| 22850 7590 09/25/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER BOLDEN, ELIZABETH A | | | | |
| ART UNIT 1793 | | PAPER NUMBER | | |
| NOTIFICATION DATE 09/25/2009 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/592,945

Applicant(s)

BERTHEREAU ET AL.

Examiner

ELIZABETH A. BOLDEN

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Information Disclosure Statements (IDS) submitted 15 September 2006, 5 December 2006, and 27 August 2007 have been considered by the Examiner.

Claim Rejections - 35 USC § 102 and 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 9 rejected under 35 U.S.C. 102(b) as being anticipated by Sproull, U.S. Patent 4,542,106.

Sproull discloses a glass fiber. See column 1, lines 9-24. Sproull discloses a glass in terms of weight percentages: SiO₂ 58-60, Al₂O₃ 11-13, CaO 21-23, MgO 2-4, TiO₂ 1-5. See Abstract and column 2, line 67 to column 3, line 3. The compositional ranges of Sproull. are sufficiently specific to anticipate the glass as recited in claims 1-5 and 9. See MPEP 2131.03.

Furthermore, Sproull discloses an Example in column 4, lines 45-55, which anticipates claims 1, 5, and 9.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gallo et al., U.S. Patent 6,136,735.

Gallo et al. disclose that the glass is for glass yarns which are made by flowing out orifices located in the bottom of a bushing. See column 1, lines 5-12. Gallo et al. disclose that the yarns maybe coated with at least one organic and inorganic material. column 6, lines 17-22 and column 7, lines 4-16. Gallo et al. disclose a glass in terms of weight percentages: SiO₂ 58-62, Al₂O₃ 10-16, CaO >18, MgO>1.5, TiO₂ less than 1.5. See Abstract and column 2, lines 3-15. The compositional ranges of Gallo et al. are sufficiently specific to anticipate the glass as recited in claims 1-5 and 7-10. See MPEP 2131.03.

However, Maeda et al. does not disclose any examples that anticipate claims 1-5 and 7-10.

Therefore, in the alternative to the § 102 rejection the reference discloses a composition that has overlapping ranges of components with the instant claimed glass, and overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. The claims are considered anticipated or in the alternative the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the overlapping portion of the range disclosed by the prior art because overlapping ranges have been held to be a *prima facie* case of obvious, see *In re Malagari*, 182 U.S.P.Q 549.

Claims 1-5, 9, and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wallenberger, U.S. Patent Application Publication 2003/0224922, now U.S. Patent 6,818,575.

Wallenberger discloses a glass for glass fibers. See paragraph [0001]. Wallenberger discloses that the fiber is drawn through a plurality of holes and made into a strand. See paragraph [0021]. Wallenberger discloses a glass in terms of weight percentages: SiO₂ 52-62, Al₂O₃ 8-16, CaO 16-25, MgO1-5, TiO₂ 0-2. See Abstract and paragraphs [0010], [0015], and

[0017]. The compositional ranges of Wallenberger are sufficiently specific to anticipate the glass as recited in claims 1-5, 9, and 10. See MPEP 2131.03.

However, Wallenberger does not disclose any examples that anticipate claims 1-5, 9, and 10.

Therefore, in the alternative to the § 102 rejection the reference discloses a composition that has overlapping ranges of components with the instant claimed glass, and overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. The claims are considered anticipated or in the alternative the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the overlapping portion of the range disclosed by the prior art because overlapping ranges have been held to be a *prima facie* case of obvious, see *In re Malagari*, 182 U.S.P.Q 549.

Claims 1-5, 9, and 10 are rejected under 35 U.S.C. 102(c) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Li, U.S. Patent 7,449,419.

Li discloses a glass for glass fibers. See column 1, lines 15-25. Li discloses that the fibers are incorporated into printed circuit boards when mixed with a polymeric matrix material. column 4, lines 18-32. Li discloses a glass in terms of weight percentages: SiO₂ 48-62, Al₂O₃ 9-16, CaO 16-25, MgO 0-6, TiO₂ 0-4. See Abstract and column 4, lines 60-67. The compositional ranges of Li are sufficiently specific to anticipate the glass as recited in claims 1-5, 9, and 10. See MPEP 2131.03.

However, Li does not disclose any examples that anticipate claims 1-5, 9, and 10.

Therefore, in the alternative to the § 102 rejection the reference discloses a composition that has overlapping ranges of components with the instant claimed glass, and overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. The claims are considered anticipated or in the alternative the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the overlapping portion of the range disclosed by the prior art because overlapping ranges have been held to be a *prima facie* case of obvious, see *In re Malagari*, 182 U.S.P.Q 549.

Allowable Subject Matter

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reason for Allowance

In reviewing the prior art for these claims, the further restriction of requiring the addition of the recited component, CoO, renders this claim allowable.

Conclusion

The additional references cited on the 892 have been cited as art of interest since they are considered to be cumulative to or less than the art relied upon in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. BOLDEN whose telephone number is (571)272-1363. The examiner can normally be reached on 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elizabeth A. Bolden
/Elizabeth A. Bolden/
Examiner
Art Unit 1793

EAB
21 September 2009

/Karl E Group/
Primary Examiner, Art Unit 1793